

REMARKS

Claims 14-18, 20-26 and 30-35 have been examined in this application. Claim 31 is amended to add a limitation found in the other independent claims, regarding the use of schema elements to encode text in an electronic document. Claims 36 and 37 are added. Applicants do not intend to add new matter by adding these claims. No fee is due for the new claims, as fees were paid for other claims that were withdrawn and cancelled in response to a restriction requirement.

We note that the Examiner has modified the grounds for rejection throughout the office action, rather than standing on the previously issued grounds. This brings into question whether this office action should have been made final.

Rejection Under 35 U.S.C. § 102(e) of Claims 14-30

The Examiner rejects **claims 14-30** under 35 U.S.C. § 102(e) as anticipated by Call (U.S. 6,418,441).

The Examiner persists in relying solely on 55 lines of non-enabling description of RDF technology, found in column 25 of Call, despite Applicants having provided extensive descriptions of the RDF technology that detail the way in which RDF works. That leaves the Examiner relying on Call's conclusory assertion of potential advantages to using RDF, without a description of the way that RDF works. We point out, from MPEP § 706.02, "for anticipation under 35 U.S.C. 102, the reference must teach **every aspect** of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present." And this rejection makes no assertion of features being inherent in RDF.

If the Examiner is actually relying on RDF technology, why is the Examiner not citing the detailed descriptions of how it works? Why rely on a secondary reference that only presents advantages of RDF, without explaining the way that it works?

Claim 14

Claim 14 includes the limitations:

A method of extending a definition of a first tag used in a first electronic document, wherein the electronic document is encoded in a markup language, and the document is stored on a server in a computer network, the method comprising:

defining the first tag in a first schema, wherein the definition of the first tag

includes a plurality of elements from the markup language;

defining a second tag in a second schema, wherein a definition of the second tag includes

a reference to the first tag that incorporates the plurality of elements from the markup language; and

an additional element from the markup language;

providing references for locating the first schema and second schema in the first electronic document, wherein the first tag and the second tag are used to encode text within the first electronic document.

These limitations are not found in Call.

Applicants' fundamental position (Resp. at 8), to which the Examiner did not respond, is, "The 55 lines regarding use of RDF to support Call's invention fall short of a written description, teaching or enablement" of RDF or the claimed inventions. The lack of response to this position impacts the Examiner's entire argument.

There are three prominent holes in the Examiner's reasoning: Nothing in Call describes a definition of a second tag that includes reference to the first tag plus additional language elements. Nothing in Call describes embedding in a first electronic document references for locating first and second schemas. Nothing in Call describes using first and second tags to encode text with in the first electronic document. Moreover, none of the Examiner's arguments suggest finding these claim aspects in Call.

One way to look at the Examiner's argument is using the familiar (if outdated) doctrine of equivalence function-way-result analysis. Claim 14 details a **way** of implementing extensibility. The Examiner's argument based on Call col. 25 asserts only a *result* of extensibility, and it does so in conclusory terms. Call col. 25 identifies RDF as a software platform, but does not provide a written description, teaching or enablement of a **way** in which RDF operates that could read on claim 14.

The Examiner argues (FOA at 4), "The metadata capabilities of XML can be used to advantage to provide an extensible system ..." This argument is based on reciting a claimed result, not any particular way of accomplishing the result. None of these words, which are quoted extensively at 4-5, read on a definition of a second tag that includes reference to the first tag plus additional language elements. Because Call does not

provide a written description, enablement or any way of defining a second tag, Call does not read on the claim. At most, the language that the Examiner quotes sounds like the preamble of claim 14, not like any of the claim elements.

The Examiner further argues (FOA at 4), that Call's technology "requires only incremental modification of a base 'product' schema and each such subclass may then be further modified to form descendent schema" This argument is again based on results and does not read on the claimed **way** of doing things. "Incremental modification" does not describe or enable a definition of a second tag that includes reference to the first tag plus additional language elements or any other part of claim 14, because it does not describe a **way** of doing anything. In fact, one of the RDF documents that we submitted, W3C, Resource Description Framework (RDF) Schema Specification (Mar. 3, 1999), at § 1.2.1, strongly suggests that RDF schema do not build on one another in the manner claimed. "Since changing the logical structure of a schema risks breaking other RDF models which depend on that schema, this specification recommends that a new URI is used whenever an RDF schema is changed. [¶] In effect, changing the RDF statements which constitute a schema creates a new one; new schema namespaces should have their own URI to avoid ambiguity. Since an RDF Schema URI unambiguously identifies a single version of a schema ..." Incremental modification of a base schema, which is stated in Call as a result without describing a way of accomplishing the result, does not read on a definition of a second tag that includes reference to the first tag plus additional language elements. It does not read on embedding in a first electronic document references for locating first and second schemas. Nor does it read on using first and second tags to encode text with in the first electronic document.

Similarly, the Examiner (FOA at 5), quotes from Call, 25:54-60, "From a practical standpoint, the creation of a simple and generic product and company description base schemas which can thereafter be extending using RDF allows basic information about products and companies to be made available early, allowing more elaborate schemas to evolve as experience with the simpler system suggests their utility." This does not describe or enable a technology that reads on claim 14, because claim 14 describes a **way** of doing something.

In essence, the passages cited by the Examiner relate only to the word “extends” in the preamble of claim 14 and not to the claimed aspects of the invention.

Therefore, claim 14 should be allowable over Call.

Claims 15 and 17-18

Claims 15 and 17-18 should be allowable over Call for at least the same reasons as claim 14, from which they depend.

Claim 16

Claim 16 includes the limitations:

wherein the second tag is used in a location reserved for the first tag in the electronic document

These limitations are not found in Call.

The Examiner did not respond to our position, either in her argument (FOA at 7) or in her response to arguments section (FOA at 13-14). We previously asserted (Resp. at 12) that the RDF documentation does not support the Examiner's notion that “magazines” can be inserted into a location reserved for “publications.” (OA at 10) The two are not interchangeable in RDF, because magazines is a subset, not a superset of publications. Call does not teach that they are interchangeable in the cited passage; we assume that the Examiner is arguing from some general principle that is not explained by Call. Moreover, it should now be clear that neither “magazines” nor “publications” is a tag in RDF, they are resource IDs. W3C, Resource Description Framework (RDF) Schema Specification (Mar. 3, 1999), at §§ 2.2.1 and 2.3.2.1

First, it is inappropriate for this to be a final rejection, when the Examiner has not responded to Applicants’ clearly stated positions. Instead, the Examiner abandoned the position (OA at 10) to which we responded and made a completely different argument (FOA at 7).

Second, Call does not include any passage that suggests that RDF works in the way claimed. The passage cited (FOA at 7) describes extensibility as a result without any mention of a **way** in which RDF works.

Third, the passage from RDF documentation that we quote above warns that modified RDF schemas may break existing applications, so a new schema should be designated with a new URI. This is just the result that the technology disclosed renders unnecessary.

Call does not come close to reading on claim 16.

Therefore, claim 16 should be allowable over Call.

Claim 20

Claim 20 includes the limitations:

accessing the second schema in a second electronic document, wherein the second tag is used to encode the second electronic document

These limitations are not found in Call.

Therefore, claim 20 should be allowable over Call.

Claims 21-24

Claims 21-24 should be allowable over Call for the same reasons as the claims from which they depend.

Claim 25

Claim 25 includes the means plus function limitations:

A computer network system for processing a document instance of a markup language, the computer system comprising:

means for defining a first tag, including a plurality of elements from a markup language, in a first schema in the computer network system;

means for extending a definition of the first tag by use of a second schema residing on the computer network system, the second schema defining a second tag by reference to the first tag that incorporates in the second schema the plurality of elements from the markup language and by including additional elements;

means for importing the second schema into the document instance.

These limitations are not found in Call.

We previously pointed out that the Examiner failed to follow the required protocol for rejection of a means-plus-function claim, as set out in MPEP §§ 2181-83, at 2100-227 *et seq.* (Rev. 5, Aug. 2006). We identified the structures corresponding to the means clauses by reference to our appellate brief. For convenience, we reproduce the relevant section here:

Claim 25 describes a computer network system for processing a document instance of a markup language. This computer system comprises the following elements: a means for defining a first schema in the computer network system; a means for extending a definition of an element in the first schema by use of a second schema residing on the computer network system; and a means for importing the second schema into the document

instance. Each of the elements of claim 25 is in means plus function form, the means including data structures in memory of a computer network system form processing a document instance. The structures corresponding to means for defining a first schema include an enhanced schema language, described on pp. 13 et seq. of the specification. See, FIG. 2. The structures corresponding to means for extending a definition of an element include the extends statement illustrated in the example on pp. 14-15. See, FIG. 2, ref 204. The structures corresponding to means for importing the second schema into the document instance include URNs, URIs and URLs directly or indirectly specified in an XML document, as illustrated on pp. 22-25. See, FIG. 2, ref 212, 214. Alternatively, the means include a processor responsive to data structures specifying definitions, extensions and imports.

The Examiner is missing the point that we made. (FOA at 15) We were referring to the language above from our appeal brief, not to the arguments about the prior rejection. Our appeal brief helps the Examiner by identifying the corresponding structures. The Examiner is free to adopt our identification of corresponding structures or to make her own identification. Either way, the Examiner must follow the required protocol for rejection of a means plus function claim.

The Examiner has not made out a *prima facie* case, as required by MPEP §§ 2183 at 2100-235 *et seq.*, because she (1) has not identified the structures corresponding to the means plus function elements and (2) has not compared the relevant structures to the reference.

Therefore, claim 25 should be allowable over Call.

Claims 26 and 30

Claims 26 and 30 should be allowable over Call for the same reasons as claim 25, from which they depend.

Applicants respectfully submit that claims 14-30 should be allowable over Call.

Rejection Under 35 U.S.C. § 103(a) of Claims 31-35

The Examiner rejects **claims 31-35** under 35 U.S.C. § 103(a) as unpatentable over Call (U.S. 6,418,441).

Claim 31

Claim 31 includes the limitations:

In a computer network system comprising a plurality of servers, a method of

interpreting an XML document, the XML document residing on a first server from the plurality of servers, the method comprising:

accessing a first schema from a second server in the plurality of servers, wherein the first schema defines one or more elements used in a document instance to encode document text;

accessing a second schema from a third server in the plurality of servers, wherein the second schema extends at least one element from the one or more elements used in the document instance by defining a new element that refers to and includes the at least one element and further includes at least one additional element.

These limitations are not found in same as above.

The Examiner acknowledges (FOA at 10-11) that Call does not teach distributing first and second schemas to different servers. Moreover, the passage that the Examiner paraphrases (FOA at 10) regarding incremental modification does not teach the **way** in which claim 31 specifies that the first and second schemas interact.

The Examiner argues that it would be obvious to modify the single reference to distribute schemas to different servers. The Examiner points to language in Call that teaches that a product code translator can be implemented by a plurality of servers that may be mirrored or clustered or assigned to subsets of UPC codes. That language has nothing to do with distributing schemas to different servers, even though the schemas are used to interpret a single electronic document. That language does not motivate one of skill in the art to modify the Call reference in the manner claimed.

As a matter of general principle, we remind the Examiner that real evidence is needed to suggest modification and support a single-reference obviousness rejection. It is fundamental, as indicated in MPEP Section 2143.01, that the Examiner rely on some evidentiary quality suggestion to modify Rangan et al.:

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual

findings with respect to the motivation to combine references); < *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The MPEP cites *In re Lee*, in which the Federal Circuit clarified the need for evidentiary quality support of an Examiner's factual basis for finding a teaching, suggestion or motivation in the prior art (as opposed to the Examiner's opinion), 277 F.3d at 1343-44:

As applied to the determination of patentability *vel non* when the issue is obviousness, "it is fundamental that rejections under 35 U.S.C. § 103 must be based on evidence comprehended by the language of that section." *In re Grasselli*, 713 F.2d 731, 739, 218 U.S.P.Q. (BNA) 769, 775 (Fed. Cir. 1983). ... "The factual inquiry whether to combine references must be thorough and searching." *Id.* It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. [citation omitted] The need for specificity pervades this authority. See, e.g., *In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2D (BNA) 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed"); *In re Rouffet*, 149 F.3d 1350, 1359, 47 U.S.P.Q.2D (BNA) 1453, 1459 (Fed. Cir. 1998) ("even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious."); *In re Fritch*, 972 F.2d 1260, 1265, 23U.S.P.Q.2D (BNA) 1780, 1783 (Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references"). ... In its decision on Lee's patent application, the Board rejected the need for "any specific hint or suggestion in a particular reference" to support the combination of the Nortrup and Thunderchopper references. Omission of a relevant factor required by precedent is both legal error and arbitrary agency action.

The outcome of cases decided even before *In re Lee* makes it clear that real evidence is required to support an asserted teaching, suggestion or motivation to modify a single reference for obviousness. See, e.g., *In re Kotzab*, 217 F.3d 1365, 1369-70 (Fed. Cir. 2000) (rev'd finding of obviousness, as "Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference."); *Kolmes v. World Fibers Corp.*, 107 F.3d 1534, 1541 (Fed. Cir. 1997) (aff'd patent not invalid, as no suggestion to modify the '989 patent with

regard to non-metallic fibers).

The Examiner's analysis thus far has not met the standard for a *prima facie* case of single reference obviousness.

Therefore, claim 31 should be allowable over Call.

Claims 32-34

Claims 32-34 should be allowable over Call for at least the same reasons as claim 31 from which they depend.

Claim 35

Claim 35 includes the limitations:

parsing the XML document, wherein the document is parsed by an XML Processor residing on a fourth server from the plurality of servers.

These limitations are not found in Call.

The Examiner interprets XML Pointer Language (Xpointer) (FOA at 12-13) as meeting this limitation. The language that the Examiner paraphrases has nothing to do with using a fourth server to parse an XML document. That is not what Xpointer language does.

Applicants respectfully submit that claims 31-35 should be allowable over Call.

CONCLUSION

Applicants respectfully submit that the pending claims are now in condition for allowance and thereby solicit acceptance of the claims as now stated.

Applicants would welcome an interview, if the Examiner is so inclined. The undersigned can ordinarily be reached at his office at (650) 712-0340 from 8:30 a.m. to 5:30 p.m. PST, Monday through Friday, and can be reached at his cell phone at (415) 902-6112 most other times.

Fee Authorization. The Commissioner is hereby authorized to charge any additional fees determined to be due in connection with this communication, or credit any overpayment, to our Deposit Account No. 50-0869 (OIN 1012-1).

Respectfully submitted,

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